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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,456	03/10/2004	James Frederick Lau	2003P13760US	4456
7590	11/25/2005		EXAMINER	
Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			LE, HOA T	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/797,456

Applicant(s)

LAU ET AL.

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 112*

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement as set forth in the last office action and further discussed below.

With regard to the “semiconductive property”, Applicant fails to identify how the property is determined, whether it represents conductivity or resistivity, and in which medium. As stated there, the value values in different media. Thus, without identifying the medium in which the “semiconductive property” is measured, the value of the property as reported is meaningless. The examiner did not question what the dimension of the property means. The examiner questioned the test method that Applicant used to measure the reported semiconductive property.

With regard to the tensile modulus for the semiconducting sheet, the instant specification fails to describe how such tensile modulus can be obtained. The specification simply reports the shape and materials of the sheet, but fails to describe the working conditions from which the tensile modulus as claimed can be obtained. It does not explain what factor controls the claimed tensile modulus for the sheet?

Applicant responded to the Examiner’s inquiry by a broad general statement that the description is clear, but fails to specifically point out where in the specification provides the answers raised by the Examiner.

3. The objection and rejection to the term “C-black resin” and the term “thin” are hereby withdrawn.

***Response to Arguments***

4. Claims 1, 4-7, 9-12 and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Quirk (US 4,091,139) for the reasons set forth in the last office action and further discussed below.

5. Claims 2, 3, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quirk (US 4,091,139) for the reasons set forth in the last office action and further discussed below.

Applicants contended that “the Examiner has apparently combined a 102(b) rejection with a 112. The examiner took issue with elements of the claim under 112, then proceed with a 102(b) as though those elements of the claims were no longer present.” Applicant is invited to review the Examiner’s previous office action on pages 4 and 5, where each element in each claim is identified in the Quirk patent.

Applicant stated that “Applicant believes ... that the responses to the 112 rejections sufficiently distinguish the present invention from Quirk”. This broad statement without going into specifics is not acceptable. Applicant fails to point out the supposed errors in the examiner’s art rejections and/or point out the specific distinctions that render the claims patentable over the Quirk patent. Moreover, the examiner cannot see how Applicant’s insufficient response to the 112 rejections satisfies the art rejections. And the examiner did not combine the two rejections as falsely alleged by Applicant. Please carefully review the

last office action. For Applicant's benefit, the examiner includes 37 CFR 1.111(b) which governs Applicant's response to an office action.

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." (emphases added)

6. Applicant stated that Applicant's invention is a sheet wedge and not a tape. One would not take a flexible insulating tape and call it a stiff semi-conductive wedge." The insulating tape taught by Quirk is sheet form, thus it is a sheet. And it's a thin sheet because at least the independent claims do not define the thickness range of the sheet that is considered to be "thin". In addition, "sheet wedge" is a preamble. A preamble is generally

not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The tape taught in the Quirk patent is a semiconductive tape, and the tape when is applied in the form of a thin sheet (see figures 1-3). So it's a semiconductive thin sheet. With regard to the term "wedge", the term "wedge" is not assigned any patentable weight because the body of the claim does not depend on this term for its completeness.

In addition, in response to applicant's statement that "one would not take a flexible insulation tape and call it a stiff semiconductive wedge", it is noted that the feature "stiff" upon which applicant relies is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Applicant's arguments filed September 13, 2005 have been fully considered but they are not persuasive for the reasons set forth above. In the future, it's requested that Applicant's response be compliant to 37 CFR 1.111. General statements and false allegations (as demonstrated in Applicant's current response) without specifics will be held non-responsive and will not be considered.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. References are cited as art of interest.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'H. T. Le', with a stylized, cursive flourish extending to the right.

H. T. Le  
Primary Examiner  
Art Unit 1773

Nov. 21, 2005